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May 25, 2005
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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re adp Gauselmann GmbH

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Serial No. 75858618

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Horst M. Kasper, Esq. for adp Gauselmann GmbH

Robin S. Chosid-Brown, Trademark Examining Attorney, Law Office 102 (Thomas V. Shaw, Managing Attorney).

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Before Seeherman, Hohein and Bucher, Administrative Trademark Judges.

Opinion by Hohein, Administrative Trademark Judge:

adp Gauselmann GmbH has filed an application to register on the Principal Register the mark "ISLAND" for "coin-operated casino, entertainment and gambling apparatuses, and devices, namely, game machines, video game machines, slot machines, video slot machines, casino video slot machines, accounting computer software, electronic cards, poker machines, electronic backgammon and parts thereof."[1]

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that

[1] Ser. No. 75858618, filed on November 23, 1999, which is based on an allegation of a bona fide intention to use such mark in commerce.

applicant's mark, when applied to its goods, so resembles the mark "GOLD ISLAND," which is registered for "gaming equipment, namely, slot machines and video slot machines with video output capability,"[2] as to be likely to cause confusion, or to cause mistake, or to deceive.

Applicant has appealed. Briefs have been filed, but an oral hearing was not requested. We affirm the refusal to register.

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence which are relevant to the factors bearing on the issue of whether there is a likelihood of confusion. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 568 (CCPA 1973). However, as indicated in Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976), in any likelihood of confusion analysis, two key considerations are the similarity or dissimilarity in the goods at issue and the similarity or dissimilarity of the respective marks in their entireties.[3] Here, inasmuch as applicant's goods (i.e., "slot machines," "video slot machines" and "casino video slot machines") are legally identical in part to registrant's goods (i.e. "slot machines" and "video slot machines with video output

[2] Reg. No. 2,053,967, issued on the Principal Register on April 22, 1997, which sets forth a date of first use anywhere and in commerce of October 16, 1995; combined affidavit §§8 and 15.

[3] The court, in particular, pointed out that: "The fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." 192 USPQ at 29.

capability"),[4] the primary focus of our inquiry is on the similarities and dissimilarities in the respective marks when considered in their entireties.

Turning, therefore, to consideration of the marks at issue, we note as a preliminary matter that, "[w]hen marks would appear on virtually identical goods ..., the degree of similarity [of the marks] necessary to support a conclusion of likely confusion declines." Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992), *cert. denied*, 506 U.S. 1034 (1994). See also ECI Division of E-Systems, Inc. v. Environmental Communications Inc., 207 USPQ 443, 449 (TTAB 1980). Applicant contends, nonetheless, that in essence the commercial impression conveyed by its mark "ISLAND" is simply "the [general] concept embedded in [the word] 'island,'" while the commercial impression engendered by registrant's mark "GOLD ISLAND" is that of a specific island. According to applicant, "a consumer will not be misled by reference to an abstract island and will not associate such concept of an abstract island with a particular island such as ... 'GOLD ISLAND.'"[5]

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[4] Applicant, we note, does not contend otherwise in its brief.

[5] Applicant, in this regard, reiterates in its brief the argument it first raised in its request for reconsideration of the final refusal. Specifically, applicant cites as support for its position the following "examples in other classes where a registration of the mark 'Island' was allowed even after registrations of specific 'Islands' had been previously registered":

> For example, a service mark registration Reg. No. 2,345,387 of the mark "Island" was performed in class 36 in the year 2000, even though registrations in class 36 had previously been registered for:

The Examining Attorney, on the other hand, contends in her brief that, when considered in their entireties, registrant's mark "GOLD ISLAND" is dominated by the term "ISLAND," which is identical to applicant's mark ISLAND. The Examining Attorney also insists that:

> Even if one accepts the applicant's argument that its mark represents any

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> Dewees Island Reg. No. 1,963,674 in the year 1996, and
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> Callawassie Island Reg. No. 2,026,987 in the year 1996.
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> Also, a trademark registration Reg. No. 2,013,560 of the mark "Island" was performed in class 29 in the year 1996, even though registrations in class 36 had previously been registered for:
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> Sea Island Reg. No. 539, 637 in the year 1951,
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> Robins Island Reg. No. 1,744,689 in the year 1993, and
>
> Claw Island Reg. No. 1,775,991 in the year 1993.

However, as the Examining Attorney correctly points out in a footnote to her brief:

> The applicant did not properly make the registrations a part of the record. The record in any application must be complete prior to appeal. [Trademark Rule] ... 2.142(d) .... Furthermore, the ... Board does not take judicial notice of registrations, and the mere submission of a list of registrations does not make these registrations part of the record. *In re Delbar Products, Inc.*, 217 USPQ 859 (TTAB 1981); *In re Duofold Inc.*, 184 USPQ 638 (TTAB 1974). To make registrations proper evidence of record, soft copies of the registrations or the complete electronic equivalent (*i.e.*, printouts of the registrations taken from the electronic search records of the United States Patent and Trademark Office) must be submitted. TMEP §710.03. *See In re JT Tobacconists*, 59 USPQ2d 1080, 1081 n. 2 (TTAB 2001) ....

Accordingly, inasmuch as the Examining Attorney's objections are well taken, the limited information furnished by applicant with respect to the third-party registrations noted above does not properly constitute part of the record herein. Nonetheless, we observe that, even if such information were to be considered, it is without any probative value because there simply is no indication as to the goods and services set forth in the third-party registrations.

> abstract island, and the Registrant's mark identifies a specific place, there is no way for a customer to know that the "islands" are not related. Consumers are likely to see the two marks side by side, or nearby, in a casino. A customer is likely to think that the gaming machines come from a family of "island" marks, [and] that the source of the goods is the same. The commercial impression and connotation of the marks, ISLAND and GOLD ISLAND, for coin operated gaming machines and slot machines is the same. Any doubt regarding a likelihood of confusion must be resolved in favor of the prior registrant. *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988) ....

We find that, due to the shared term "ISLAND," the marks at issue are so highly similar in their overall sound, appearance, connotation and commercial impression that, when used in connection with such identical items of gambling devices or gaming equipment as "slot machines" and "video slot machines," including "casino video slot machines," confusion as to the source or sponsorship thereof is likely to occur. There is simply nothing, moreover, in this record which indicates that either purchasers of such goods or the users thereof would distinguish registrant's mark "GOLD ISLAND" from applicant's "ISLAND" mark on the basis that the former designates a real or actual geographic place while the latter signifies only a generalized or nonspecific location. Instead, both marks essentially connote an isolated place which is typically surrounded by water.[6]

[6] We judicially notice, in this regard, that The American Heritage Dictionary of the English Language (4th ed. 2000) at 927 defines "island" as, inter alia, "**1**. A land mass, especially one smaller than a continent, entirely surrounded by water." It is settled that the Board may properly take judicial notice of dictionary definitions. See, e.g., Hancock v. American Steel & Wire Co. of New Jersey, 203

Furthermore, while not addressed by applicant, the *du Pont* factor of the conditions under which and buyers to whom sales are made (i.e., "impulse" versus careful, sophisticated purchasing) also favors a finding of a likelihood of confusion. Although casino operators and managers would clearly be careful and discriminating purchasers, the actual users or players of casino gaming machines and other gambling devices are obviously ordinary consumers who could be expected to act on impulse with respect to the coin-operated casino equipment which they choose to play. Specifically, having experienced good (or bad) luck while playing, for instance, a "GOLD ISLAND" slot machine or video slot machine, such players would be likely to play (or avoid) an "ISLAND" slot machine or video slot machine on the assumption that such gaming machines share a common origin or affiliation in that the former is a version of the latter or vice versa.

We accordingly conclude that purchasers and users who are familiar or otherwise acquainted with registrant's "GOLD ISLAND" mark for "gaming equipment, namely, slot machines and video slot machines with video output capability," would be likely to believe, upon encountering applicant's highly similar mark "ISLAND" for, *inter alia*, such legally identical "coin-operated casino, entertainment and gambling apparatuses ... and devices" as "slot machines, video slot machines, [and] casino

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F.2d 737, 97 USPQ 330, 332 (CCPA 1953); University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc., 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983); and Marcal Paper Mills, Inc. v. American Can Co., 212 USPQ 852, 860 n. 7 (TTAB 1981).

video slot machines," that the respective goods emanate from, or are otherwise sponsored by or affiliated with, the same source. In particular, as noted above, such consumers would be likely to view applicant's "ISLAND" goods as part of a line of gaming machines and gambling devices from the same source as that of registrant's "GOLD ISLAND" products.

Decision: The refusal under Section 2(d) is affirmed.